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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,758	10/19/2001	Daniel M. Makowiecki	IL-10939	5973

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EXAMINER	
MILLER, EDWARD A	
ART UNIT	**PAPER NUMBER**
3641	

DATE MAILED: 06/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/032,758	MAKOWIECKI ET AL.
	Examiner	Art Unit
	Edward A. Miller	3641

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 February 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-80* is/are pending in the application.

4a) Of the above claim(s) *1-16,30-53 and 68-80* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *17-29 and 54-67* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-80* are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 17-29 and 54-67 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, and for containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

This relates to the disclosure as to "limited life". This term is not adequately disclosed such as to describe how to practice the invention, or enable one of ordinary skill in the art to adequately use the invention. The reasons set forth in parent application SN 08/998,370, which rejection was affirmed by the Board of Appeals, is incorporated herein by reference.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 17-29 and 54-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Throughout the meaning of the relative term "limited life" is unclear, such that the metes and bounds of the invention cannot be reasonably determined. The term "limited life" in the claims is a relative term which renders the claim indefinite. It is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art

would not be reasonably apprised of the scope of the invention. Further, there are a number of other deficiencies, including claims 28-29 which do not, contrary to the recitation of claim 17, e.g., make or produce any limited life material. Instead, the products of claims 28-29, inconsistently, are powdered reaction products which will have an unlimited life and also will fail to be explosive. In claim 85, "etc." renders the metes and bounds indefinite. These are exemplary.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 17-29 and 54-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dixon et al., in view of Danen et al. '132.

Dixon et al. teach preparing a primer which contains MIC of Danen et al. It is deemed obvious to prepare such an explosive. It is further obvious the a "metastable" explosive must inherently have a limited life. Further, it appears that the dependent claims recite ingredients and layers such that the instant claims inherently read on the layered explosive of Dixon et al. and Danen et al. If the claims fail to define over what is literally written in the references, then the claims must inherently include such. To the extent appropriate, variation of parameters, notoriously well known ingredients, etc., would have been obvious to one of ordinary skill in the art. It is well settled that optimizing a result effective variable is well within the expected ability of a person or ordinary skill in the subject art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955).

7. Claims 17-29 and 54-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makowiecki et al. '911 and '748 and Makowiecki '799.

Variation of parameters, to the extent required, would have been obvious. Note the above cited case law. Certain of these references may, at least as to the broad claims, inherently yield limited life structures. Indeed, these references may be the epitome of obviousness, anticipation, as to the claims that are more broadly defined. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

These are earlier references involving at least one of instant applicants. However, all these references are more than one year prior to the instant application filing date. Thus, they are deemed to apply in the first instance. As to this, see *In re de Seversky*, 177 USPQ 144 (CCPA 1973), and *In re Schneider*, 179 USPQ 46 (CCPA 1973). To the extent that applicants may take advantage of the provisions of 35 USC 103 (c), applicants have not taken the steps necessary to satisfy those provisions of the statute.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached Monday-Thursday, from 10 AM to 7 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Carone can be reached at (703) 306-4198. The Group fax number is (703) 305-7687.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em
June 2, 2003

EDWARD A. MILLER
PRIMARY EXAMINER